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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/767,143
Filing Date: January 29, 2004
Appellant(s): CHARROPPIN, PASCAL

Stacey Fluhart
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08 December 2010 appealing from the Office action mailed 28 April 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-10 are rejected.

(4) Status of Amendments After Final

Claim 1 and claim 5 were amended in an After Final Amendment filed on 28 July 2010. Claim 1 was amended to include a limitation found in claim 5, but not in claim 1. Thus, claim 1 was amended to be similar in scope to that of claim 5. The amendments filed after final were accepted.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being

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maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

NEW GROUND(S) OF REJECTION

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al (US 7,103,583) in view of Boothby (US 5,684,990), Dlugos et al (US 6,463,133), and Markl (US 5,710,706).

As per **claim 1**, Baum et al discloses a device alerting to the expiration of tariffs for a franking system, comprising a random access memory (RAM) for recording postal data (col 4, line 63-col 5, line 10) including:

a first table of postal tariffs relative to postal products and services, said first table of tariffs comprising postal tariffs applicable before a date of application (col 6, lines 34-54, memory area '16-02'),

a second table of postal tariffs relative to postal products and services, said second table of tariffs comprising postal tariffs applicable after said date of application (col 6, lines 34-54, memory area '16-01'); and

wherein said processing unit further comprises means for emitting to a franking system, a message alerting that postal data corresponding to the mail item to be franked has been changed, if it has been determined from said comparison of said postal data that at least one of the postal data corresponding to the mail item to be franked has changed (col 8, lines 53-62, communicating an instruction to implement a conversion).

Although Baum et al does not explicitly disclose a processing unit comprising comparing means for comparing one by one postal data in said first table of postal tariffs with corresponding postal data in said second table of postal tariffs, Baum et al does disclose the release order number of the previous postage fee schedule (first table) is compared to the version number of the postage fee schedule to be loaded in the future (second table) (col 7, lines 45-54). Furthermore, Baum et al further discloses that the release number is the combination of a version and revision number (col 10, lines 22-24, revision number indicates that there is a change in data). While in Baum et al the release numbers of the tables are compared instead of the postal tariffs of the tables, it would have been obvious to one of ordinary skill in the art at the time of the invention to compare the postal tariffs in the tables instead of the release date for the similar reason of indicating a change in postal tariffs and to yield the predicted outcome of ensuring that the postal tariffs being utilized in the franking machine are valid and updated, as suggested by Baum et al (col 7, lines 46-48). Furthermore, Boothby shows the known technique of comparing one by one data in a first table with corresponding data in a second table to determine that at least one of the data has changed (Abstract; col 5, line 58-col 6, line 39; col 9, lines 25-35). This known technique is applicable to the system of Baum as they both share characteristics and capabilities, namely, they are directed to synchronizing databases. One of ordinary skill in the art would have recognized that applying the known technique of Boothby would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the known technique of Boothby to the teachings

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of Baum would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data synchronization features into similar systems. Further, applying the comparison of the data one by one to Baum with the postal data stored accordingly would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow better accuracy.

While Baum et al discloses means for emitting to a franking system a message alerting that postal data corresponding to the mail item to be franked has been changed, if it has been determined from said comparison of said postal data that at least one of the postal data corresponding to the mail item to be franked has changed (col 8, lines 53-62, communicating an instruction to implement a conversion), Baum et al does not disclose emitting a message to the operator of the franking system; and means for receiving a decision of the operator whether to replace the postal tariffs of the first table with the postal tariffs of the second table, for updating the postal tariffs at the operator's request.

However, Dlugos et al discloses emitting to the operator of the franking system a message alerting to the expiration of tariffs (col 4, lines 32-35); and said device further comprises means for emitting the alert message to the operator upon a determination that there is a change in the postal tariffs (col 4, lines 32-35), whereupon the operator decides whether to replace the postal tariffs of the first table with the postal tariffs of the second table (col 4, lines 31-35; col 4, line 55- col 5, line 15; module "30" contains postal rate tables, and user plugs in module "30" to download new rate data into

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module "30"). It would have been obvious to one of ordinary skill in the art to include in the postal system of Baum et al in view of Boothby the ability to emit to an operator that postal tariffs are expiring, and allow the operator to replace the expired tables as taught by Dlugos et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Baum et al in view of Boothby and Dlugos et al does not further disclose the device further comprising a franking machine which franks the mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date. However, Markl et al discloses when an effective date of a postal table has been reached, an out of date table can be used to continue to frank mail items (col 1, lines 20-34). Markl et al further discloses determining what portions of postal data has been changed and updating the corresponding changed data when the updating data have become valid (col 4, line 57-col 5, line 3). Thus, Markl et al suggests that if it is determined that the postal data has not changed, the franking machine continues to operate with the current postal data after the effective date. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Baum et al in view of Boothby and Dlugos et al to include the method of Markl et al to save time and resources by not updating data that has not changed

As per **claim 2**, Baum et al further discloses wherein said second table of postal tariffs is loaded in the franking system at a periodicity defined by the Postal Service (col 9, lines 22-25).

As per **claim 3**, Baum et al further discloses wherein said second table of postal tariffs is loaded in the franking system from a remote resetting centre (col 3, lines 6-7).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al (US 7,103,583) in view of Boothby (US 5,684,990), Dlugos et al (US 6,463,133), and Markl et al (US 5,710,706) as applied to claim 1, and in further view of Thiel (US 6,321,214).

As per **claim 4**, While Baum et al in view of Boothby, Dlugos et al, and Markl et al disclose loading a second table of postal tariffs in the franking system (Baum et al: col 7, lines 45-54), Baum et al in view of Boothby, Dlugos et al, and Markl et al do not disclose wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded. However, Thiel discloses wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded (col 22, lines 18-25). Therefore it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Baum et al in view of Boothby, Dlugos et al, and Markl et al to include the method disclosed by Thiel for the advantage of convenience, efficiency, and in order to be sure the proper rates are always present on the customer system.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

7,103,583	BAUM et al	09-2006
5,684,990	BOOTHBY	4-1997
6,463,133	DLUGOS et al	10-2002
6,321,214	THIEL	11-2001
5,710,706	MARKL et al	1-1998
4,516,014	ECKERT	5-1985

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 5-7 and 9-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al (US 7,103,583) in view of Boothby (US 5,684,990) and Dlugos et al (US 6,463,133) as applied to claim 1, and in further view of Official Notice.

As per **claim 5**, Process for alerting to the expiration of tariffs for a franking system comprising:

a first table of postal tariffs relative to postal products and services, said first table of tariffs comprising postal tariffs applicable before a date of application (col 6, lines 34-54, memory area '16-02'),

a second table of postal tariffs relative to postal products and services, said second table of tariffs comprising postal tariffs applicable after said date of application (col 6, lines 34-54, memory area '16-01'); and

wherein said processing unit further comprises means for emitting to a franking system, at the time of franking, a message alerting that postal date corresponding to the mail item to be franked has been changed, if it has been determined that at least one of the postal data corresponding to the mail item to be franked has changed (col 8, lines 53-62, communicating an instruction to implement a conversion).

Although Baum et al does not explicitly disclose a processing unit comprising comparing means for comparing one by one postal data in said first table of postal tariffs with corresponding postal data in said second table of postal tariffs, Baum et al does disclose the release order number of the previous postage fee schedule (first table) is compared to the version number of the postage fee schedule to be loaded in the future (second table) (col 7, lines 45-54). Furthermore, Baum et al further discloses that the release number is the combination of a version and revision number (col 10, lines 22-24, revision number indicates that there is a change in data). While in Baum et al the release numbers of the tables are compared instead of the postal tariffs of the tables, it would have been obvious to one of ordinary skill in the art at the time of the invention to compare the postal tariffs in the tables instead of the release date for the

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similar reason of indicating a change in postal tariffs and to yield the predicted outcome of ensuring that the postal tariffs being utilized in the franking machine are valid and updated, as suggested by Baum et al (col 7, lines 46-48). Furthermore, Boothby shows the known technique of comparing one by one data in a first table with corresponding data in a second table to determine that at least one of the data has changed (Abstract; col 5, line 58-col 6, line 39; col 9, lines 25-35). This known technique is applicable to the system of Baum as they both share characteristics and capabilities, namely, they are directed to synchronizing databases. One of ordinary skill in the art would have recognized that applying the known technique of Boothby would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the known technique of Boothby to the teachings of Baum would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data synchronization features into similar systems. Further, applying the comparison of the data one by one to Baum with the postal data stored accordingly would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow better accuracy.

While Baum et al discloses means for emitting to a franking system, at the time of franking, a message alerting that postal date corresponding to the mail item to be franked has been changed, if it has been determined that at least one of the postal data corresponding to the mail item to be franked has changed (col 8, lines 53-62, communicating an instruction to implement a conversion), Baum et al does not disclose

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emitting a message to the operator of the franking system; and means for receiving a decision of the operator whether to replace the postal tariffs of the first table with the postal tariffs of the second table, for updating the postal tariffs at the operator's request.

However, Dlugos et al discloses emitting to the operator of the franking system a message alerting to the expiration of tariffs (col 4, lines 32-35); and said device further comprises means for emitting the alert message to the operator upon a determination that there is a change in the postal tariffs (col 4, lines 32-35), whereupon the operator decides whether to replace the postal tariffs of the first table with the postal tariffs of the second table (col 4, lines 31-35; col 4, line 55- col 5, line 15; module "30" contains postal rate tables, and user plugs in module "30" to download new rate data into module "30"). It would have been obvious to one of ordinary skill in the art to include in the postal system of Baum et al the ability to emit to an operator that postal tariffs are expiring, and allow the operator to replace the expired tables as taught by Dlugos et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Baum does not explicitly disclose when it is determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date. However, the Examiner takes Official Notice that it is old and well known in the

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art at the time of the invention to continue to operate a franking machine with the current postal data when it is determined that the postal data has not changed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of the modified Baum to include franking the mail item with the current postal data when it is determined that the current postal date has not changed so that there is no disruption in service.

While Baum in view of Boothby and Dlugos et al disclose a decision of the operator of whether to replace the current postal data with new postal data, Baum and Dlugos do not disclose receiving the decision on a keyboard. However, the Examiner takes Official Notice that it is old and well known in the art at the time of the invention to receive a decision from an operator via a keyboard. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the modified Baum to include receiving on the keyboard a decision by the operator because a keyboard is a known way to receive instructions from an operator.

As per **claim 6**, Baum et al further discloses wherein the new postal data are stored at the location of the current postal data when the operator has accepted the updating of these postal data (col 4, lines 12-22).

As per **claim 7**, Baum et al further discloses wherein the current postal data are stored in a blank part of the RAM, to be kept for control purposes (col 6, lines 14-17; col 7, lines 58-61).

As per **claim 9**, Baum et al discloses wherein the postal data comprise postal tariffs (col 12, lines 52-54).

As per **claim 10**, Baum et al further discloses wherein the postal data comprise postal products and services (col 12, lines 52-54).

3. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al (US Patent 7,103,583) in view of Boothby (US 5,684,990), Dlugos et al (US 6,463,133), and Official Notice as applied to claim 5, and in further view of Eckert (US 4,516,014).

As per **claim 8**, While Baum et al in view of Boothby, Dlugos et al, and Official Notice disclose emission of a message alerting to the expiring of tariffs (Dlugos et al: col 4, lines 32-35), Baum et al in view of Dlugos et al and Official Notice do not disclose wherein the emission of the message alerting to the expiration of tariffs is inhibited by the operator except for the first such message after the franking system has been put into operation. However, Eckert discloses wherein emission of an alerting message is inhibited by an operator except for the first such message after the franking system has been put into operation (col 8, line 66-col 9, line 14, Examiner interprets a message to be the same as a warning light). It would have been obvious to one of ordinary skill in the art to include in the postage system of the modified Baum et al the ability to inhibit an alerting message as taught by Eckert since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

NEW GROUND(S) OF REJECTION

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al (US 7,103,583) in view of Boothby (US 5,684,990), Dlugos et al (US 6,463,133), and Markl (US 5,710,706).

As per **claim 1**, Baum et al discloses a device alerting to the expiration of tariffs for a franking system, comprising a random access memory (RAM) for recording postal data (col 4, line 63-col 5, line 10) including:

a first table of postal tariffs relative to postal products and services, said first table of tariffs comprising postal tariffs applicable before a date of application (col 6, lines 34-54, memory area '16-02'),

a second table of postal tariffs relative to postal products and services, said second table of tariffs comprising postal tariffs applicable after said date of application (col 6, lines 34-54, memory area '16-01'); and

wherein said processing unit further comprises means for emitting to a franking system, a message alerting that postal data corresponding to the mail item to be franked has been changed, if it has been determined from said comparison of said postal data that at least one of the postal data corresponding to the mail item to be franked has changed (col 8, lines 53-62, communicating an instruction to implement a conversion).

Although Baum et al does not explicitly disclose a processing unit comprising comparing means for comparing one by one postal data in said first table of postal

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tariffs with corresponding postal data in said second table of postal tariffs, Baum et al does disclose the release order number of the previous postage fee schedule (first table) is compared to the version number of the postage fee schedule to be loaded in the future (second table) (col 7, lines 45-54). Furthermore, Baum et al further discloses that the release number is the combination of a version and revision number (col 10, lines 22-24, revision number indicates that there is a change in data). While in Baum et al the release numbers of the tables are compared instead of the postal tariffs of the tables, it would have been obvious to one of ordinary skill in the art at the time of the invention to compare the postal tariffs in the tables instead of the release date for the similar reason of indicating a change in postal tariffs and to yield the predicted outcome of ensuring that the postal tariffs being utilized in the franking machine are valid and updated, as suggested by Baum et al (col 7, lines 46-48). Furthermore, Boothby shows the known technique of comparing one by one data in a first table with corresponding data in a second table to determine that at least one of the data has changed (Abstract; col 5, line 58-col 6, line 39; col 9, lines 25-35). This known technique is applicable to the system of Baum as they both share characteristics and capabilities, namely, they are directed to synchronizing databases. One of ordinary skill in the art would have recognized that applying the known technique of Boothby would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the known technique of Boothby to the teachings of Baum would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such

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data synchronization features into similar systems. Further, applying the comparison of the data one by one to Baum with the postal data stored accordingly would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow better accuracy.

While Baum et al discloses means for emitting to a franking system a message alerting that postal data corresponding to the mail item to be franked has been changed, if it has been determined from said comparison of said postal data that at least one of the postal data corresponding to the mail item to be franked has changed (col 8, lines 53-62, communicating an instruction to implement a conversion), Baum et al does not disclose emitting a message to the operator of the franking system; and means for receiving a decision of the operator whether to replace the postal tariffs of the first table with the postal tariffs of the second table, for updating the postal tariffs at the operator's request.

However, Dlugos et al discloses emitting to the operator of the franking system a message alerting to the expiration of tariffs (col 4, lines 32-35); and said device further comprises means for emitting the alert message to the operator upon a determination that there is a change in the postal tariffs (col 4, lines 32-35), whereupon the operator decides whether to replace the postal tariffs of the first table with the postal tariffs of the second table (col 4, lines 31-35; col 4, line 55- col 5, line 15; module "30" contains postal rate tables, and user plugs in module "30" to download new rate data into module "30"). It would have been obvious to one of ordinary skill in the art to include in the postal system of Baum et al in view of Boothby the ability to emit to an operator that

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postal tariffs are expiring, and allow the operator to replace the expired tables as taught by Dlugos et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Baum et al in view of Boothby and Dlugos et al does not further disclose the device further comprising a franking machine which franks the mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date. However, Markl et al discloses when an effective date of a postal table has been reached, an out of date table can be used to continue to frank mail items (col 1, lines 20-34). Markl et al further discloses determining what portions of postal data has been changed and updating the corresponding changed data when the updating data have become valid (col 4, line 57-col 5, line 3). Thus, Markl et al suggests that if it is determined that the postal data has not changed, the franking machine continues to operate with the current postal data after the effective date. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Baum et al in view of Boothby and Dlugos et al to include the method of Markl et al to save time and resources by not updating data that has not changed

As per **claim 2**, Baum et al further discloses wherein said second table of postal tariffs is loaded in the franking system at a periodicity defined by the Postal Service (col 9, lines 22-25).

As per **claim 3**, Baum et al further discloses wherein said second table of postal tariffs is loaded in the franking system from a remote resetting centre (col 3, lines 6-7).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al (US 7,103,583) in view of Boothby (US 5,684,990), Dlugos et al (US 6,463,133), and Markl et al (US 5,710,706) as applied to claim 1, and in further view of Thiel (US 6,321,214).

As per **claim 4**, While Baum et al in view of Boothby, Dlugos et al, and Markl et al disclose loading a second table of postal tariffs in the franking system (Baum et al: col 7, lines 45-54), Baum et al in view of Boothby, Dlugos et al, and Markl et al do not disclose wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded. However, Thiel discloses wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded (col 22, lines 18-25). Therefore it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Baum et al in view of Boothby, Dlugos et al, and Markl et al to include the method disclosed by Thiel for the advantage of convenience, efficiency, and in order to be sure the proper rates are always present on the customer system.

(10) Response to Argument

Appellant argues, with respect to claim 5, "As disclosed by Dlugos, when tariffs are out of date, and new tariffs are available, the new tariffs automatically replace the old tariffs. The Examiner's position is not at all true if the date of the application of the subject current data is out of date...That is, in Dlugos, the tariffs are automatically updated and the user has no choice as to whether or not to replace the tariffs. If the user does not replace the tariffs, he cannot frank mail items anymore... In the Advisory Action dated November 8, 2010, the Examiner cited MarkI (U.S. 5,710,706) as support for the Officially Noticed position, specifically pointing to column 1, lines 20-33 (see page 2 of Advisory Action). However, this disclosure of MarkI describes that a new rate table cannot be installed prior to the effective date of the rates in the new table, which causes a risk that out-of-date postal information may be installed in the postal scale unless the new table can be installed on the effective date of the new table...Thus, it would not have been obvious to have modified Baum, Boothby, and Dlugos based on the fact that it is known that an out of date table of rates may be undesirably applied only if a new rate table has not been installed as of the effective date of the new table...Thus, it is respectfully submitted that the combination of claim 5 is patentable over the cited art at least because none of the cited art disclose or suggest "when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date." First, the Examiner notes that the rejection is based on the combined teachings of Baum, Boothby, Dlugos et al, and

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Official Notice. The Applicant challenged the Examiner's use of Official Notice in the After Final filed 28 July 2010. In order to substantiate the Examiner's previous use of Official Notice, the Examiner cited Markl et al as teaching the limitations for which the Examiner took Official Notice. Specifically, Markl et al, at column 1, lines 20-33, was relied upon for disclosing "when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date". Although the Examiner had cited column 1, lines 20-33 of Markl et al as applied to the claims for the convenience of the applicant, the specified citations were only representative of the teachings in the art and were applied to the specific limitations within the individual claim, other passages and figures also apply. The Applicant should have fully considered the reference in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passages as taught by the prior art or disclosed by the Examiner. So to further support the Examiner's position that Markl et al suggests the limitations found in claim, the Examiner also directs the Appellant's attention to column 4, line 58-col 5, line 3. Specifically, Markl et al further discloses, "The invention also permits planning an early preparation of postage rate tables which contain a scheduled modification of the postage rate values, so that these can be made accessible to all postal customers before the change officially takes effect. It is important to equip the majority of users with a current postage rate table ahead of the official effective date instead of attempting to do so simultaneously, as was heretofore tried. Each user of the mail processing system receives a message from the data

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center regarding what portion of the relevant data contents shall be initially modified and is thus in the position to implement the corresponding data updating when the updating data have become valid.” Since when determining whether the postal data has changed, on the effective date, it is also determined what portions of the postal data to update; it is obvious that if the postal data has not changed, on the effective date, the machine continues to frank the mail items with the current postal data. Thus, Markl et al suggests the Applicant’s claim 5 limitations of “when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date.”

Appellant further argues, “Applicant submits that the rejection of claim 1 is in error for failure to establish a prima facie case of unpatentability, and should be reversed.” However, the Examiner disagrees. An after final amendment was filed 28 July 2010. The After final amendment added limitations to claim 1 that were previously found in claim 5; but the limitations were not found in claim 1 previously. The Examiner accepted the amendments to claim 1 after final. The Examiner was never formally given an opportunity to present a rejection to claim 1 including the newly amended limitations. However, since the scope of claim 1 and claim 5 are closely aligned, the rejections that apply to claim 1 also apply to claim 5; and should be maintained for the same reasons as given above with respect to claim 5.

Appellant also argues, “Furthermore, it is respectfully submitted that claim 1 is also patentable over the combined teachings of Baum, Boothby, and Dlugos because it

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would not have been obvious to have combined these references to arrive at the claimed invention, in which a comparing means compares one by one postal data in a first table with postal data in a second table. In the invention of claim 1, by comparing the postal data one-by-one, the user may choose to replace an old tariff with a new tariff without necessarily replacing the entire table.... However, the reason why Boothby compares the data records one by one is because the data records of the first "table," e.g., a handheld computer, and the data records of the second "table," e.g., a desktop computer, are each independently updated (see column 1, lines 16-17)." However, the Examiner asserts that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Appellant also argues, "It is noted that the Examiner may not have understood the Applicants' argument. Applicants had argued that the motivation for providing this feature in Boothby is not necessary in Baum, the primary reference. Consequently, it would not have been obvious to have modified Baum based on Boothby, irrespective of any additional advantages that result from such a hypothetical combination." However, the Examiner asserts that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d

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413, 208 USPQ 871 (CCPA 1981). In this case, the combined teaching of Baum with Boothby teach that selectively looking at each record of a table for comparison with another record to determine whether data has changed is old and well known.

Furthermore, Markl et al discloses, "The invention also permits planning an early preparation of postage rate tables which contain a scheduled modification of the postage rate values, so that these can be made accessible to all postal customers before the change officially takes effect. It is important to equip the majority of users with a current postage rate table ahead of the official effective date instead of attempting to do so simultaneously, as was heretofore tried. Each user of the mail processing system receives a message from the data center regarding what portion of the relevant data contents shall be initially modified and is thus in the position to implement the corresponding data updating when the updating data have become valid" (col 4, line 58-col 5, line 3). Thus, suggesting that comparing each record in a postage rate table is known.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Shannon S Saliard/

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Primary Examiner, Art Unit 3628

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

John Hayes, SPE 3628

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628

Vincent Millin/vm/

Appeals Specialist